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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,959

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Xavier Blin

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/784,959	Applicant(s) BLIN ET AL.	
	Examiner Melissa S. Mercier	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6-14-05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-62 are pending in this application. Receipt of the Information Disclosure Statement filed on June 14, 2005 is acknowledged. Applicants claim of priority to provisional application 60/452,107 filed on March 6, 2003 is acknowledged.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application, by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Objections

Claim 41 is objected to because of the following informalities: the claim recites "an amount equal to more than more than 95%". It appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 1-57 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner what the first composition is. The only limitation of the first composition is that it comprises a physiologically acceptable medium, which applicant's specification discloses as a non-toxic physiologically acceptable medium which can be applied to the skin, epidermal derivatives and/or lips of the face of human beings (paragraph 0160). The examiner is therefore interpreting the medium to be any component, which is non-toxic to humans.

It is further unclear to the examiner if the product is one or two separate and distinct compositions or two compositions mixed together to form one composition. Dependent claims 55-56 disclose the cosmetic make up product is in the form of a foundation, a blush, eye shadow, lipsticks, eyeliner, congealers, and body makeup products. These forms are all one composition. Therefore it is unclear what product applicant is claiming in Claim 1.

Additionally it is unclear in claim 56, what products having care properties would encompass. It is the examiner's position that any product can be formulated to comprise some active agent that would have a therapeutic, cosmetic, physiological, or beneficial effect.

Further regarding claims 38-41, it is unclear what applicant is claiming by the limitation "are both present in an amount equal to more than 70%, 80%, 90%, and

95%, respectively, by weight". It is unclear how both components can be present at the percentages disclosed since that would be more than 100% of the composition.

Further regarding claim 45, it is unclear what filmable means. The examiner is interpreting this limitation to be film forming. It is suggested applicant amend the claim to read, "wherein the polymer particles are film-forming particles".

Regarding Claim 62, it is unclear to the examiner what epidermal derivatives would encompass. Clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10, 17-21, 23-32, and 36-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 2003/0039621).

Arnaud discloses a cosmetic make-up product containing a first and a second composition, the first composition comprising, in a physiologically acceptable medium, dispersed polymer particles surface-stabilized with a stabilizer in a liquid organic phase and a coloring agent, and the second composition comprising a second physiologically acceptable medium (abstract). The two compositions may be applied successively to the skin, nails, eyebrows, eyelashes and hair (paragraph 0003). The compositions are disclosed as having the properties of "transfer resistance", migration resistance, staying power, comfort, absence of dehydration, and gloss (paragraph 0021). The composition can be packaged separately or together in the same packaging article or distinct packaging articles (paragraph 0026). Arnaud discloses the cosmetic make-up product can be in the form of a foundation, a face powder, an eyeshadow, a lipstick, a product especially having care properties, an eyeliner, a concealer product or a body make-up product (of the tattoo type).

Regarding Claims 44-51, the first composition comprises polymer particles in dispersion, which is soluble in the liquid organic phase or fatty phase (paragraph 0044). Film-forming polymers may be used (paragraph 0054). The amount of polymer may be greater than 2% by weight (paragraph 0045). Examples of film forming polymers include polyurethanes, polyurethane-acrylics, polyureas, polyurea-polyurethanes, polyester-polyurethanes, polyether-polyurethanes, polyesters, polyesteramides, alkyd fatty-chain polyesters; acrylic and/or vinyl polymers or copolymers; acrylic-silicone copolymers; polyacrylamides; silicone polymers, for instance silicone acrylics or polyurethanes, fluoro polymers, and mixtures thereof (paragraph 0072).

Regarding claims 52-53, the stabilizer may be a block polymer, a graft polymer, or a random polymer (paragraph 0075). Grafted-block or block copolymers which can also be used are copolymers comprising at least one block resulting from the polymerization of at least one ethylenic monomer, containing one or more optionally conjugated ethylenic bonds, such as ethylene, or dienes such as butadiene or isoprene, and of at least one block of a vinyl, or preferably styrene, polymer. Suitable polymers include block copolymers in particular of "diblock" or "triblock" type (paragraph 0081).

Regarding Claims 53-57, the first composition and second compositions are preferably in anhydrous form (paragraph 0225). Each composition may have the appearance of a lotion, cream, ointment, soft paste, salve, a cast or molded solid, or a more or less rigid stick (paragraphs 0226-0227).

The second composition comprises a second physiologically acceptable medium preferably, a liquid phase that is non-volatile at room temperature and atmospheric temperature (paragraphs 00152-153). The non-volatile liquid phase may be a silicone-based phase that is liquid at room temperature and/or a fluoro based phase that is liquid at room temperature (paragraph 0156).

A mixture of low viscosity silicone oil and high viscosity silicone oil is disclosed as a preferred embodiment (paragraph 0196). Arnaud discloses silicone oil with the same formula of instant claim 10 in paragraph 0169. It is the examiners position that as the molecular weight of the polymer increases, the viscosity would also increase, and vice versa, therefore, it is the examiners position that one of ordinary skill in the art would have the knowledge to select polymers with the desired viscosities/molecular weights in order to obtain a composition with the desired characteristics.

Regarding claims 30-32, suitable silicone oils include phenyl trimethicone, a phenyl dimethicone, a phenyltrimethylsiloxydiphenylsiloxane, a diphenyl dimethicone, a diphenylmethyldiphenyltrisiloxane or a mixture of different phenylsilicone oils (paragraph 0189).

The second composition may comprise a coloring agent (paragraph 0137) or a wax (paragraph 0218). The reference discloses the second composition may comprise but does not require the addition of the component, therefore, it is the examiners position that one of ordinary skill in the art at the time the invention was made would have been able to add or not add the components.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of high molecular weight polymer and a low molecular weight polymer, to prepare a cosmetic/make up composition, because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

Claims 11-16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 2003/0039621) in view of Wood et al. (US Patent 5,332,569).

The teachings of Arnaud are discussed above and applied in the same manner.

Arnaud does not disclose the use of dimethicone or dimethiconol as the high molecular weight polymer or the composition being transparent.

Wood discloses a liquid hair care composition for conditioning the hair with silicone oils. (abstract). The two most common types of hair conditioning silicone oils are referred to in the International Cosmetic Ingredient Dictionary (CTFA) as "dimethicone" and "dimethiconol". Dimethicone is defined as a mixture of fully methylated linear siloxane polymers end blocked with trimethylsiloxy units. Dimethiconol is a dimethyl silicone polymer terminated with hydroxyl groups. Such hair conditioning

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silicone oils are relatively non-volatile liquids, which are obtainable from commercial sources in the United States and other countries. For example, silicone fluids are sold by Dow Corning Corporation, Midland, Mich. Among the silicone oils (also called fluids) supplied by Dow Corning for use in hair treating compositions is a solution of high-viscosity dimethiconol fluid in dimethicone (column 1, lines 30-35). Both fluids are also known to be clear and would therefore; result in a transparent composition in the absence of coloring being added.

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that silicone polymers effective ingredients in compositions for treating skin, it would have been obvious to combine these polymers with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 2003/0039621) in view of Dubief et al. (US Patent 5,160,730).

The teachings of Arnaud are discussed above and applied in the same manner.

Arnaud does not disclose the use of polydimethylsiloxanes as a low molecular weight polymer.

Dubief discloses an aqueous dispersion for the treatment of hair or skin. Debrief discloses silicone oils, including polydimethylsiloxanes are commonly used as lubricants in cosmetic compositions (column 1, lines 14-16).

It has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that silicone polymers effective ingredients in compositions for treating skin, it would have been obvious to combine these polymers with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Conclusion

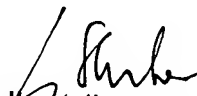
No claims are allowable. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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